

**REMARKS**

## REJECTION UNDER 35 U.S.C. §103

A. Claims 1-4 and 10-11 are rejected under 35 U.S.C. §103(a) as being unpatentable over Okayama (USPN 6,097,517) in view of Kuroyanagi et al. (USPN 6,072,610) and further in view of Jahreis (USPN 5,959,748).

Claim 1 has been amended to include the terminology -- and distributing the repeated wavelength-non-multiplexed optical signal to "m" pieces of routing units-- immediately after "an intra-office signal input unit provided with said intra-office transmission lines, for repeating the wavelength-non-multiplexed optical signal entered from each of said intra-office transmission lines to said first optical path group" to show more clearly that the intra-office signal input unit is not a router, but rather is a distribution unit that sends a wavelength-non-multiplexed optical signal to a router.

That is, the Examiner's argument that a router such as router 11c of Okayama may be substituted for the intra-office signal input unit is respectfully submitted not to be practical, since the present invention already has a routing unit to which the distributor, i.e., the intra-office signal input unit, sends the wavelength-non-multiplexed optical signal. Since a router is typically a piece of hardware or software that connects two or more networks by functioning as a sorter and interpreter as it looks at addresses and passes bits of information to their proper destinations, the substitution of a router immediately before another router in the present invention would result in greater complexity and higher cost than using the distributor of the present invention.

Hence, it is respectfully submitted that Okayama teaches a wavelength router and, as the Examiner notes, does not specifically disclose an intra-office input unit for repeating a non-multiplexed optical signal. In addition, it is respectfully submitted that there is no teaching or suggestion of combining the optical branch unit of Kuroyanagi et al. with Okayama. Also, neither Okayama nor Kuroyanagi et al. teaches converting the input optical signals into predetermined wavelengths.

Although Jahreis teaches wavelength converters, it is respectfully submitted that there is no teaching or suggestion of combining Jahreis with Okayama and/or Kuroyanagi. It is respectfully submitted that the courts have held that the Examiner may not suggest modifying references using the present invention as a template absent a suggestion of the desirability of the modification in the prior art. *In re Fitch*, 23 U.S.P.Q.2d 1780, Fed Cir. 1992. Something in the prior art as a whole must suggest the desirability, and thus, the obviousness, of making the

combination. *Alco Standard Corp. v. Tennessee Valley Authority*, 808 F. 2d 1490, 1 U.S.P.Q. 2d 1337 (Fed. Cir. 1986). When a rejection depends on a combination of prior art references, there must be some teaching, suggestion or motivation to combine the references. *In re Geiger*, 815 F.2d 686, 688 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). Thus, since there is no teaching or suggestion of modifying Okayama and combining Jahreis with the modified Okayama or combining Jahreis with Kuroyanagi et al., it is respectfully submitted that claims 1-4 and 10-11 are patentable under 35 U.S.C. §103(a) over Okayama in view of Kuroyanagi et al. and further in view of Jahreis.

B. Claims 5-6 are rejected under 35 U.S.C. §103(a) as being unpatentable over Okayama (USPN 6,097,517) in view of Kuroyanagi et al. (USPN 6,072,610) and in view of Jahreis (USPN 5,959,748) and further in view of Suzuki et al. (USPN 5,005,166).

The teachings of Okayama, Kuroyanagi et al., and Jahreis are described above. It is respectfully submitted that Suzuki et al. was filed in Japan September 30, 1987 and in the U.S. September 30, 1988, issuing as a U.S. patent on April 2, 1991. Thus, Suzuki et al. was known to those skilled in the art when Okayama was filed September 1, 1995 in Japan and August 30, 1996 when Okayama was filed in the U.S., and if it had been obvious to the inventors to combine the optical switch and branch unit of Suzuki with the Okayama invention, the inventor Okayama had the opportunity to do so. Thus, it is respectfully submitted that it was not obvious to do so since Okayama did not combine the optical switch and branch unit of Suzuki et al. with the Okayama invention. Also, there is no teaching or suggestion to combine Suzuki et al. with Okayama, Kuroyanagi et al., and/or Jahreis.

As set forth above, the courts have held that the Examiner may not suggest modifying references using the present invention as a template absent a suggestion of the desirability of the modification in the prior art. *In re Fitch*, 23 U.S.P.Q.2d 1780, Fed Cir. 1992. Something in the prior art as a whole must suggest the desirability, and thus, the obviousness, of making the combination. *Alco Standard Corp. v. Tennessee Valley Authority*, 808 F. 2d 1490, 1 U.S.P.Q. 2d 1337 (Fed. Cir. 1986). When a rejection depends on a combination of prior art references, there must be some teaching, suggestion or motivation to combine the references. *In re Geiger*, 815 F.2d 686, 688 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987).

Thus, it is respectfully submitted that claims 5-6 are allowable under 35 U.S.C. §103(a) and are patentable over Okayama (USPN 6,097,517) in view of Kuroyanagi et al. (USPN 6,072,610) and in view of Jahreis (USPN 5,959,748) and further in view of Suzuki et al. (USPN 5,005,166).

C. Claims 7-8 are objected to as being dependent upon a rejected base claim,

but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 7 has been cancelled since the subject matter of claim 7 has been incorporated into its respective independent claim, claim 3. Thus, amended claim 3 is submitted to be allowable.

Since claim 8 indirectly depends from amended claim 3, claim 8 is submitted to be allowable for at least the reasons that amended claim 3 is submitted to be allowable.

#### CONCLUSION

Claims 1 and 3 have been amended. Claim 7 has been cancelled without prejudice or disclaimer. Claims 1-6, 8 and 10-11 are pending.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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By: Darleen J. Stockley  
Darleen J. Stockley  
Registration No. 34,257

1201 New York Ave, N.W., Suite 700  
Washington, D.C. 20005  
Telephone: (202) 434-1500  
Facsimile: (202) 434-1501